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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,131	06/24/2003	Bohumil Pergl	J400-003 CIP	1600
21706	7590	05/10/2006	EXAMINER CHEN, TIANJIE	
NOTARO AND MICHALOS 100 DUTCH HILL ROAD SUITE 110 ORANGEBURG, NY 10962-2100			ART UNIT 2627	PAPER NUMBER

DATE MAILED: 05/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/602,131

Applicant(s)

PERGL, BOHUMIL

Examiner

Tianjie Chen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Final Rejection

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pierson (US 5,982,736) in view of Schroeder et al (US 5,791,990).

Claim 1, Pierson shows a compact disc in Figs. 1-5 (Column 5, line 11) of non-circular shape in Figs. 1-4 including: disc body having a central annular portion 37 and recording portion 21 (Fig. 4); recording layer 21 (Column 5, lines 25-28) and reflective layer 24 (Column 5, line 59-61) provided on the recording portion of disc body and covered by a protective coating 26 (Column 6, line 10); a basic cover paint 29 (Column 6, lines 16-20) applied to the annular portion.

Pierson does not show at least one defined area with a border and central portion situated in the annular recording portion containing a hidden printing, a scratch-off coating covering the defined area.

Schroeder et al teaches a compact disk (Column 3, lines 25) can be used for different media (Column 4, lines 29-30), which includes at least one defined area 240 (Fig. 5A) with left border and right border and central portion situated between the left and right borders containing a hidden printing (activation cod); and a scratch-off coating 220 (Fig. 5A; column 7, line 58) covering the defined area.

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It would have been obvious at the time the invention was made to one of ordinary skill in the art to apply Schroeder et al's scratch-off figure into Pierson's device. The rationale is as follows: Pierson's disc is an optical disc, which can be used for game (Column 1, lines 28-29). Schroeder et al's design is used for decrease the possibility of fraud (Column 2, lines 59-60) for games (Column 4, lines 36-38). One of ordinary skill in the art would have been motivated to apply Schroeder et al's scratch-off printing into Pierson's disc for reducing possibility of fraud.

Claim 5, Schroeder et al shows the scratch-off paint coating in Fig. 5 bears activation code, which guides user for activating computer, which is a guidance printing.

2. Claims 2, 3, 6, 8-10, 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pierson in view of Schroeder et al as and Schaefer et al (US 5,992,892).

Claim 6, the above described Pierson and Schroeder et al's device includes a compact disc of non-circular shape including: a disc body having central annular portion and a recording portion; a recording and reflective layer provided on the recording portion of the disc body and covered protective coating; a basic cover paint applied the annular portion; at least one defined area with border and central portion situated in the annular recording portion above the basic cover paint 29 and containing a hidden printing.

Claims 2 and 6; Schroeder et al does not show the detailed structure of the scratch-off layer.

Schaefer et al shows scratch-off printing in Fig. 5, wherein the defined area printing (the "Game Play Data") is separated from the scratch-off paint ("Scratch Off Coating") by a translucent interlayer ("clear varnish Release Layer") (Claim 2), and which has a translucent interlayer coating (clear varnish release layer) covering the defined area; and a scratch-off paint coating applied to the interlayer coating (Claim 6). Since Schroeder et al does not show the way of making the scratch-off structure. Schaefer shows how to workable structure for the scratch-off element. One of ordinary skill in the art would have been motivated to apply Schaefer et al's structure in to Schroeder et al's device for making it workable.

Claims 8 and 9, the above constructed Pierson, Schroeder et al, and Scheafer et al's device is a compact disc of non-circular shape including: an optically readable disc body having a central annular portion and a recording portion; a recording and a reflective layer provided on the recording portion of the disc body and covered by a protective coating; a basic cover paint having a basic printing applied to the annular portion; at least one defined area with a border and central portion situated in the annular or recording portion above the basic paint containing a hidden printing; a scratch-off paint coating covering the defined area; and a means (translucent interlayer), which separated the defined area from the scratch-off paint for protecting the hidden printing when applying and removing the scratch-off paint.

Claims 3 and 10, Applicant does not disclose unexpected result for setting the particular 2 mm, not 2.5 or 1.5 mm. One of ordinary skill in the art would determine how much should be the width, by which the interlayer coating overlaps the border portion of the defined area. Scheafer et al shows in Fig. 5 that the interlayer overlaps the whole area of the defined area. Pierson shows the width of the card is 3.5 inches =

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89 mm (Column 8, lines 11-14). Schroeder et al shows that the scratch-off area 220 has a width, which is more than one half of the card. One of ordinary skill in the art would have been reasonably expecting that the width of the defined area is more than 50 mm. The interlayer would overlap the border more than 2 mm.

Claim 12, Schroeder et al shows the scratch-off paint coating in Fig. 5 bears activation code, which guide user to activate computer, which is guidance printing.

Claim 13, Pierson shows that the basic printing is directly applied to the annular portion.

Claim 14, Pierson shows that only one reflective layer is provided on the recording portion of the disc body.

3. Claims 4, 7, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pierson in view of Schroeder et al and Schaefer et al as applied to claim 3 and 6 above, and further in view of Otani et al (JP 11-238262A).

With regard to claim 7, the above Pierson, Schroeder et al, and Schaefer et al device shows that the translucent interlayer overlaps the border portion of the defined area by at least 2 mm.

With regard to claims 4, 7, and 12; Schaefer et al does not show the thickness of the interlayer.

Otani et al teaches an interlayer having a thickness of 40-50 microns, which can be well adhered ({0013} and SOLUTION). One of ordinary skill in the art would have been motivated to apply this thickness for being well adhered.

Response to Arguments

Applicant's arguments filed 02/17/2006 have been fully considered but they are not persuasive.

- Regarding to argument 1 (a): Pierson teaches that trading card is an optical compact disc and Schroeder et al teaches his design can be used for compact disc (column 3, lines 25-26) and for other (other than magnetic) media for computers (Column 4, lines 29-32). The media used for computers are magnetic or optical. The media other than magnetic should be optical.

“Reducing fraud” is common desire in the art and in the society.

- Regarding to argument 1(b): “photograph, sketch” on the disc are a paints. The “indicia” covers the annular area, although it also covers other area.
- Regarding to argument 1(c): as described above, Schroeder et al teaches that scratch-off coating can be used for media other than magnetic in computer, which is optical medium.
- Regarding to argument 1(d): In response to applicant’s argument that the references fail to show certain features of applicant’s invention, it is noted that the features upon which applicant relies (i.e., the features recited above) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).
- Regarding to argument 2(a): “clear “ means “translucent”
- Regarding to argument 2(b): an accurate reasoning has been presented in rejection.

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- Regarding to argument: as described above Schroeder et al teaches that scratch-off coating can be used for media other than magnetic in computer, which is optical medium.

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

The prior art made of record in PTO-892 Form and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tianjie Chen whose telephone number is 571-272-7570. The examiner can normally be reached on 8:00-4:30, Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa Nguyen can be reached on 571-272-7579. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


TIANJIE CHEN
PRIMARY EXAMINER